

Attorney Docket: 540754-0000025
Client Reference: 4API/256US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: Confirmation Number: 7138
Lee, et al.

Application No.: 10/706,050 Group Art Unit: 2871
Filed: November 13, 2003 Examiner: Nguyen, Hoan C.
Title: DISPLAY APPARATUS AND LIGHT GUIDE PLATE THEREOF

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- PRE-APPEAL BRIEF REQUEST FOR REVIEW -

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Sir:

Appellants hereby request that a panel of Examiners formally review the legal and factual basis of the rejection in the above-identified application prior to the filing of an Appeal Brief. Appellants assert that the outstanding final rejection (now on Appeal by virtue of the concurrently filed Notice of Appeal) is clearly improper based upon errors in law and facts.

I. APPEALED REJECTIONS

Appellants request review of the following rejections presented in the Final Office Action ("Final Action") dated March 26, 2008:

- claims 1-3, 6-9, 11-13, 16-19 and 21-23, under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.
- claims 1-3, 11-13, 21 and 22 being allegedly anticipated under 35 U.S.C. 102(e) by U.S. Patent No. 7,019,714 to Uchida et al. ("Uchida").

II. ARGUMENTS FOR TRAVERSAL

- a. Claims 1-3, 6-9, 11-13, 16-19 and 21-23 do comply with the written description requirement under 35 U.S.C. §112, first paragraph.

The Final Action alleges that the “unitary display panel’ [including] one display unit [having] different illumination modes [is not disclosed] in the specification and [not] clearly illustrat[ed] in the drawings.” [Final Action, page 2]. Appellants strenuously disagree and submit that this assertion is factually and legally incorrect.

First, Appellants draw the Office’s attention to FIG. 1 of the present application where a unitary display panel is clearly shown, as recited in the claims. FIG. 1, shows a single panel 10, i.e. a unitary display panel, that is divided into a first area 11 and a second area 12. The Office’s attention is also drawn to the accompanying description in paragraph 16 of the present patent application where it is stated, “*a display apparatus 100 includes a panel 10, which has a first area 11 and a second area 12. The first area 11 is configured to display first data 21. The second area 12 is configured to display second data 22.*” Paragraph 25 of the present patent application further states, “*the panel 10 has two areas, [but] the number of the display areas defined in a panel is not limited to 2.*” These descriptions clearly convey to those skilled in the art that the panel 10 is not a combination of different panels (like, e.g. panels 10 and 20 in Uchida (US 7019714)), but a unitary panel with two or more areas defined thereon. The mode of operation of the unitary display panel 10 is described for example, at paragraph 24 of the present patent application, which discloses different illumination modes of the panel 10. These modes include a first mode (standby mode) where the first light source 31 is in ON state and the second light source 32 is in OFF state, so only the first area 11 of the panel 10 shows information; and a second mode where both the first light source 31 and the second light source 32 are in ON state, so the first area 11 and the second area 12 together display complicated information.

Moreover, paragraph [0019] of the Specification further shows the Appellants were in possession of the claimed invention, where Appellants clearly disclose that, “[*with the light guide structure 50*], *the light provided by the first light source 31 is concentrated in the first area 11 without leaking to the second area 12.*” If the first area 11 and the second area 12 were separate panels, as Examiner suggested in the Advisory Action, there would be no leaking problems, and Appellants’ light guide structure 31 would be redundant.

Furthermore, in paragraph [0005] of the Specification, Appellants identified the drawback of the conventional art as “[*w*]hen *only some regions of the LCD device are used to display data, activating the maximum brightness level of the light source to illuminate the entire display area becomes a waste of power. For example, when the mobile phone is in a standby mode or an idle mode, a user only needs to check the caller identification or the*

phone number shown in a small region with respect to the display area before receiving any incoming call.” While the conventional mobile phone illuminates the entire area of a single panel, the disclosed embodiments of the invention provide illumination to only a partial area of a single panel.

Further, the fundamental inquiry for determining compliance with the written description requirement is not whether the specification recites *verbatim* each and every feature of a claim, as suggested by the Office; rather, as noted above, it is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. “In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide an *in haec verba* support for the claimed subject matter at issue.” Purdue Pharma L.P. v. Faulding Inc., 56 USPQ2d 1481 (Fed. Cir. 2000), citing Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). See also MPEP §2173.05(e) (“[t]here is no requirement that the words in the claim **must match** those used in the specification disclosure” and “Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.”) Furthermore, “[a]n applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as **words, structures, figures, diagrams** and formulas that fully set forth the claimed invention.” See MPEP §2163(I) citing Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966 (emphasis added). Thus, the underlying determination in the Final Action that a claim necessarily fails to comply with the written description requirement of 35 U.S.C. §112, first paragraph, simply because a claim term is not used *verbatim* in the detailed description is incorrect at law and not in line with the Office’s own rules and policies.

Thus, claims 1-3, 6-9, 11-13, 16-19 and 21-23 do comply with the written description requirement under 35 U.S.C. §112, first paragraph, and this rejection must be withdrawn.

b. Claims 1-3, 11-13, 21 and 22 are not anticipated by U.S. Patent No. 7,019,714 to Uchida et al. (“Uchida”).

Claim 1 recites a display apparatus selectively operated in a first mode and a second mode, said display apparatus comprising, *inter alia*, “a unitary display panel having a viewer side and a back side, said viewer side divided into a first area and a second area, in response

to an image signal, said first area and said second area configured to display variable data on said viewer side." The cited portions of Uchida do not disclose, teach or render obvious these features of claim 1.

Specifically, the cited portions of Uchida fail to disclose, teach or suggest the use of a unitary display panel having a viewer side and a back side, said viewer side divided into a first area and a second area. Rather, the cited portions of Uchida specifically disclose two separate displays - EL panel 10 and LCD panel 20. See, Uchida at FIGS. 4 and 5, and col.6, lines 55-61 "[t]he mobile terminal electronic apparatus (portable telephone) 200 of the present embodiment has a built in a mobile terminal telephone apparatus body 201, an organic EL display (organic EL panel) 10 that has a full color active matrix display, and a transfective liquid crystal display device (liquid crystal panel) 20 that is a full color active matrix display." As such, the cited portions of Uchida not only fail to teach a *unitary display panel* having a viewer side and a back side, as required by the claims, but indeed teach away from such a limitation.

Thus, Appellants submit that the Office has failed to provide a proper novelty rejection under 35 U.S.C. §102(e) since, "the identical invention must be shown in as complete detail as is contained in the ... claim." (See MPEP §2131, citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), emphasis added). Further, "the elements must be arranged as required by the claim." (See MPEP §2131, citing In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), emphasis added).

Further, Appellants strenuously disagree with various assertions made in the Final Action. For example, the Office asserts that "said first area and said second area are illuminated with inherently substantially same brightness by said first light source and said second light source simultaneously." See Final Action at page 3, emphasis added. This assertion is not supported by facts. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). See MPEP 2112. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). See MPEP 2112, Emphasis added. Further, "[i]n

relying upon the theory of inherency, the examiner **must** provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.” (See MPEP § 2112 citing Ex Parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). See MPEP 2112, Emphasis added. Here, the Office has not provided any evidence whatsoever to support the determination that it is inherent that the first area and the second area of Uchida are illuminated with substantially the same brightness by the first light source and the second light source simultaneously. There simply is none. Accordingly, Appellants respectfully submit that the Office’s reliance on the theory of inherency is improper.

Accordingly, independent claim 1 is clearly patentable. Independent claims 11 and 21 are also clearly patentable for at least the same reasons of claim 1. Claims 2, 3, 6-9, 12, 13, 16-19, 22 and 23 are also patentable at least by virtue of dependency from independent claims 1, 11 and 21, respectively, as well as for their additional recitations.

III. Conclusion

Appellants respectfully submit that, for at least the reasons detailed herein, the Examiner has not met the initial burden of establishing obviousness, as the applied references fail to teach or suggest all the features recited in the rejected claims. Appellants, therefore, submit that claims 1-3, 6-13 and 16-22 are clearly patentable and a decision by the review panel to this effect is respectfully and earnestly solicited.

Respectfully submitted,

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